

**REMARKS**

Applicant has carefully reviewed the Application in light of the Office Action transmitted September 4, 2008 ("*Office Action*"). Claims 1-25 are pending in the Application, and the Examiner rejects all pending claims. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

**I. Rejections under 35 U.S.C. § 112**

The Examiner rejects Claims 1-25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

With respect to Claims 1, 9, 17, and 25, the *Office Action* asserts that "Applicant has not defined any means to determine a provider as 'satisfactory' or to rank those that are satisfactory." *Office Action*, p. 3. The claim language itself and the specification, however, clearly describe "determin[ing] whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and rank[ing] each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers." The specification recites that, by "[u]sing elements such as service registry 24, organization agent 22 can discover one or more potential services 18 for fulfilling a specified business function." P. 10. Thus, contrary to the *Office Action's* assertion, Applicant has provided means to determine a provider as 'satisfactory' and means to rank those that are satisfactory.

With respect to Claim 9, the *Office Action* also asserts that Applicant's disclosure does not disclose how an "agent" establishes a database. *Office Action*, p. 3. Applicant respectfully submits that the claim terms should take their plain, ordinary meaning, given their context in the claim language and the descriptions in the specification, as would be attributed by one of ordinary skill in the art. In context, Claim 9 recites that "an organization agent . . . establish[es] an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements." As example support for this type of function, consider descriptions in the specification that recite, in part:

"Within organization 14, organization agent 22 handles this dynamic discovery and interaction by interfacing with service providers 12 and other elements of system 10. To perform organization management, organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors. During operation,

organization agent 22 uses information from plans to identify business requirements and services 18 for potentially fulfilling those requirements.” P. 8.

Thus, contrary to the *Office Action’s* assertion, Applicant has disclosed how an “agent” establishes a database, given its context in the claim language and the descriptions in the specification.

Accordingly, Claims 1, 9, 17, and 25 comply with the enablement requirement, and Applicant respectfully requests the Examiner to withdraw the rejection and allow these claims.

The Examiner additionally rejects Claims 9-16 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With respect to Claim 9’s “organization agent,” the *Office Action* argues that the system components or structure is not claimed such that one understands the structure required to carry out these steps. *Office Action*, p. 4. Applicant respectfully submits, however, that Claims 9-16 are definite without amendment because the meaning of these claims would be clear to one of ordinary skill in the art. *See* M.P.E.P. § 2173.02. Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). “If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.” MPEP §2173.04. Accordingly, a term is not indefinite merely because it lacks structural elements; rather, terms may take the plain and ordinary meanings that are consistent with the specification.

In Claim 9, the plain and ordinary meaning of the phrase “organization agent” would be clear to one of ordinary skill in the art in light of the specification. For example, Applicant’s specification recites: “Within organization 14, organization agent 22 handles this dynamic discovery and interaction by interfacing with service providers 12 and other elements of system 10. To perform organization management, organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors.” P. 8. The specification also recites: “Interface 42 provides a link between agent 40 and other entities within system 10. Depending upon the particular types of communications and configurations within system 10, interface 42 may include any suitable

combination of hardware and/or logic for interacting with other components.” P. 15. Moreover, the claim language itself recites “an organization agent coupled to the service providers and the service registry using a communication network.”

Because the meaning of the phrase “organization agent” would be clear to one of ordinary skill in the art in light of the specification, Applicant submits that Claims 9-16 are, in fact, definite and comply with 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests the Examiner to withdraw the rejection and allow these claims. Attorneys for Applicant stand ready to conduct a telephone conference if the Examiner would like to further discuss these issues.

## **II. Rejections under 35 U.S.C. § 101**

The Examiner rejects Claims 1-25 under 35 U.S.C. §101 because they are directed to non-statutory subject matter. Under the rule recently enunciated in *In re Bilski*, an invention is patent-eligible if it (1) is tied to a particular machine or apparatus; or (2) transforms a particular article into a different state or thing. *In re Bilski*, No. 2007-1130, slip op. (Fed. Cir. October 30, 2008). Under this rule, a patent-eligible process cannot be purely a fundamental principle (law of nature, natural phenomena, or abstract idea) or a purely mental process. *Id.* at 7.

With respect to Claims 1-8, the *Office Action* argues that the claimed process steps are not tied to another statutory class, such as a particular apparatus. *Office Action*, p. 6. Applicant respectfully submits, however, that Applicant’s process is patent-eligible because it transforms the template from a first state to a second state.

With respect to Claims 9-16, the *Office Action* argues that the claimed service providers are not patent-eligible because they encompass human beings. According to Applicant’s specification, however, the meaning of the phrase “service providers” does not encompass human beings. The Specification provides: “Each service provider 12 represents any suitable collection of components capable of offering access to services through defined interfaces. Service providers 12 offer machine readable interfaces that enable structured queries to access and interact with information regarding services 18.” *Specification*, p. 6, ll. 14-17. Thus the phrase “service providers” cannot be interpreted to encompass human beings. In addition, even if the meaning of the phrase “service providers” were interpreted to encompass human beings, the claim language itself refutes any such interpretation, reciting

“service providers each having a network address, a plurality of features providing access to a service, and a plurality of service descriptors describing the service.” Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 9-16 under § 101 and allow these claims.

**III. Rejections under 35 U.S.C. § 103**

**A. Claims 1-7, 9-15, 17-23, and 25 are patentable over the *Das-Vashistha* combination.**

The Examiner rejects Claims 1-7, 9-15, 17-23, and 25 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2003/0023499 to Das, et al. (“*Das*”) in view of U.S. Patent Publication No. 2001/0051913 to Vashistha, et al. (“*Vashistha*”). Applicant respectfully traverses this rejection and submits that *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest the combination of limitation recited in the claims.

Consider Applicant’s independent Claim 1, which recites:

A method for automated management of business services comprising:  
establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;  
accessing a service registry using the business function indicator to identify a network address for each of a plurality of service providers each having a service indicator matching the business function indicator;  
for each of the identified service providers:  
communicating with the service provider to determine feature interfaces for interacting with the service provider;  
accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; and  
determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and  
ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.

Among other aspects, *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest (1) “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;” and (2) “accessing at least one of the feature interfaces of the service

provider to determine a plurality of service descriptors describing a service provided by the service provider,” as Claim 1 requires.

***i. Das and Vashistha fail to teach or suggest establishing an organizational database.***

Claim 1 requires “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements.” As teaching these aspects, the *Office Action* relies on *Vashistha*, paragraphs 36 and 38. In particular, the *Office Action* argues that since “buyer and supplier profiles are entered such that the outsourcing system can suitably match buyers and providers, therefore, it is obvious that a business function indicator is disclosed that enables identification of the provider.” *Office Action*, p. 6. *Vashistha*’s entering of buyer and supplier profiles for purposes of matching buyers and providers, however, fails to teach “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements,” as Claim 1 recites.

The *Office Action* provides no basis in fact and/or technical reasoning to support its mere assertions that *Vashistha* teaches “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements,” as Claim 1 recites. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present . . . . Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” M.P.E.P. § 2112; *see In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Accordingly, *Vashistha* fails to teach or suggest “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements,” as Claim 1 requires. *Das* fails to remedy the deficiencies of *Vashistha*.

**ii. *Das and Vashistha fail to teach or suggest accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider.***

Claim 1 requires “accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider.” As teaching these aspects, the *Office Action* relies on *Das*, paragraphs 47, 48, 50, 52, and 68. In general, *Das* discloses a system for automatically making operational purchasing decisions. In the cited portion, *Das* provides, “[e]ach time a counteroffer is received, the purchasing system determines whether it is acceptable, using its internal rules and parameters.” *Das*, ¶ 68. The *Office Action* argues that “parameters are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider.” *Office Action*, p. 7. The *Office Action* therefore merely concludes that *Das*’s negotiation involves descriptors and then equates those fictional descriptors to the claimed service descriptors. The *Office Action*, however, fails to establish that *Das*’s purchasing system ever “determine[s] a plurality of service descriptors describing a service,” as Claim 1 recites. As mentioned above, if the Office Action here is intending to imply that the descriptors are inherent, a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art must be provided. M.P.E.P. § 2112. Accordingly, the cited portion of *Das* fails to teach or suggest the step of “accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider,” as Claim 1 recites. *Vashistha* fails to remedy the deficiencies of *Das*.

Independent Claims 9 and 17 include limitations that, for substantially similar reasons, are not taught by *Das* and *Vashistha*. Because *Das* and *Vashistha* do not teach or suggest every element of independent Claims 1, 9, and 17, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, and 17 and their respective dependent claims.

**B. *Claims 8, 16, and 24 are patentable over the Das-Vashistha-Chun combination.***

The Examiner rejects Claims 8, 16, and 24 under 35 U.S.C. §103(a) as unpatentable over *Das* in view of *Vashistha* in further view of U.S. Publication No. 2002/0184527 to Chun

et al ("*Chun*"). As described above, Applicant has shown that *Das* and *Vashistha* fail to disclose all limitations of independent Claims 1, 9, and 17. Accordingly, *Das* and *Vashistha* fail to teach or suggest all limitations of Claims 8, 16, and 24 because these dependent claims incorporate the limitations of their respective independent claims. *Chun* fails to remedy the deficiencies of *Das* and *Vashistha*.

Thus, *Das*, *Vashistha*, and *Chun*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 8, 16, and 24. Because the references fail to teach all limitations of the claims, Applicant respectfully requests reconsideration and allowance of Claims 8, 16, and 24.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of this Application.

If the Examiner feels prosecution of the present Application may be advanced by a telephone conference, Applicant invites the Examiner to contact the undersigned attorney at (214) 953-6584.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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